

REMARKS

Claims 44-49 and 53-55 have been amended. Claim 57 has been newly added. No new matter has been introduced. Claims 8-16, 18-21, 38-40, 44-49 and 52-57 are now pending in the application.

In response to the election requirement, Applicants hereby elect the species covered by Species 3: Fig. 12, claims 44-49 and 53-56, with traverse. The broad claims of Species 3, e.g., claim 44, define subject matter which is also included in claims 8, 16, 18-20, 38-40 and 52-57 such that examination of the claims of Species 3 will necessarily include a search and examination of subject matter included in the Species 1 and 2 claims (i.e., claims 8-16, 18, 19-21 and 38-40). Accordingly, no undue burden would be involved in examining all such claims together.

M.P.E.P. § 803 states that “if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.” M.P.E.P. § 803 should apply in this case. The search of the elected claims (species 3) will require searching in areas also pertinent to the subject matter of the non-elected species claims (i.e., species 1 and 2). Thus, all claims of the application can be examined together “without serious burden.” Applicants, therefore, respectfully request that the non-elected claims of species 1 and 2 be examined together with the elected claims.

The Office Action acknowledges that claims 52 and 56 are generic of species 1 and 2, but states that species 3 has no generic claim. Applicants respectfully disagree, however to expedite prosecution, submit that newly added claim 57 is considered generic to all species and is allowable over the cited prior art. Claim 57 recites “[a] game apparatus operated by motions of a game player opposed to a display screen comprising: an operating means to be operated by the game player; and a position

detector for detecting a trace of the operation by the game player, the trace being made by detecting a plurality of successive spatial positions of the operation by the game player and connecting said plurality of detected positions.” The teachings of Lipps (U.S. Patent No. 5,741,182), Fenner (U.S. Patent No. 5,009,501) and Suzuki (U.S. Patent No. 6,227,968) cannot be fairly stated as disclosing, teaching or suggesting the recited limitations of claim 57.

M.P.E.P. § 806.04(d) states that, in an application illustrating several species, “a generic claim should include no material element additional to those recited in the species claims, and . . . the claims to the species which can be included in a case in addition to a single species must contain all the limitations of the generic claim.” Claim 57 includes all limitations disclosed by the species claims and does not contain any material elements additional to those recited in the independent species claims. Therefore, claim 57 is generic to independent claims 8, 16, 18-20, 38-40, 44-49 and 52-56. Furthermore, all other non-elected claims depend from the independent claims. An independent claim is necessarily generic to their respective dependent claims. Thus, claim 57 is generic to all claims. Upon the allowance of a generic claim, Applicants should be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141.

Claims 44-49 and 53-56 stand objected to based on certain informalities. Applicants have amended the claims to address the concerns of the Office Action. The preamble of claims 44-49 and 53-55 now recite “a motion of a game player.” The other listed informalities have also been corrected. Applicants respectfully request that the objection be reconsidered.

Claims 44-49 and 53-55 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lipps et al. (U.S. Patent No. 5,741,182) ("Lipps"), in view of Fenner et al. (U.S. Patent No. 5,009,501) ("Fenner"), and Suzuki et al. (U.S. Patent No. 6,227,968) ("Suzuki"). The rejection is respectfully traversed.

Claim 44 recites, *inter alia*, a game apparatus operated by a motion of a game player, comprising "a display unit being configured to display at a single prescribed appearance position on a display screen at least two command marks indicating at least two different operations in accordance with a rhythm of music, and to command a prescribed position to which the operation is to be carried out." Claims 45-49 recite similar limitations.

Claim 53 recites, *inter alia*, a game apparatus operated by a motion of a game player, comprising "[a] display unit being configured to display at a single prescribed appearance position on a display screen at least two command marks indicating at least two movements different from each other in accordance with a rhythm of music, and to command a prescribed position to which the operation is to be carried out." Claims 54 and 55 recite similar limitations.

As stated by the Office Action, neither Lipps nor Fenner teach or suggest "a command mark with a command of a specific operation." (Office Action at 5). Thus, the Office Action seeks to overcome this deficiency by combining Suzuki, and has cited Suzuki as teaching a game machine providing a player with a plurality of command marks blown out from a prescribed position, with each having different commands associated with each other.

Suzuki refers to a game machine providing a player with a plurality of command marks blown out from a plurality of prescribed positions with each being

associated with different commands. The different commands depend upon the plurality of prescribed positions, for example, (1) the command M1 indicating a left arrow blown out from the most left prescribed position S1; (2) the command (if any) indicating a down arrow must be blown out from the second prescribed position S2; (3) the command M3 indicating an up arrow must be blown out from the third prescribed position S3; and (4) the command (if any) indicating a right arrow must be blown out from the most right prescribed positions S4. (See FIG. 9 of Suzuki). To the contrary, in the claimed invention, at least two command marks indicating at least two different commands are displayed so as to be blown out from one prescribed position to which the operation is to be carried out, that is, a moving direction of the operation.

For at least the reasons set forth above, Lipps, Fenner, and Suzuki, whether considered alone or in combination, fail to teach or suggest the limitations of claims 44 and 53. Claims 45-49, 54 and 55 recite similar limitations, and thus should be allowable along with claims 44 and 53. Accordingly, Applicants respectfully request that the rejection be withdrawn and the claims allowed.

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

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Respectfully submitted,

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